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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/743,118
Filing Date: December 22, 2003
Appellant(s): WEHLING ET AL.

Allison Johnson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/20/2007 appealing from the Office action mailed 12/22/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,627,972	GIOFFRE et al	12-1986
4,687,662	SCHOBEL	8-1987

4,471,871	ROCKLIFFE et al.	9-1984
3,629,468	ANDERSEN	12-1971

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3 and 5-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gioffre et al. (US 4,627,972 here after '972) in view Schobel et al. (US 4,687,662 here after '662) or Rockliffe et al (US 4,471,871 here after '871) or Howard P. Andersen (US 3,629,468 here after '468).

Claims 1,3 and 5-36 are drawn to an effervescent composition comprising menthol, eucalyptus oil and an acid and a base as an effervescent agent wherein claim 27-28 are drawn to a package kit, 29-31 are drawn to mouthwash, and 32-36 are drawn to method of forming an aqueous effervescent composition.

The '972 patent discloses an effervescent composition comprising menthol, eucalyptus oil and anhydrous base medium and a gas containing inorganic oxide

material as an effervescent agent. Preferably flavor and sweetening agent together comprise from about 0.1 to 10% or more of the effervescent compositions (see column 4, lines 22-56). The patent '972 also discloses various other compatible and suitable materials incorporated in the chewable effervescent tablets, wherein solids and liquids are proportioned similarly to the amounts desirable and the flavor is blended with the solids and liquids, and a waxy matrix such as polyethylene glycol, coloring or whitening agents, sweetening agents such as sorbitol, an acid/base reaction couple as an additional in situ source of a gas is desired, in an amounts which do not substantially adversely affect the properties and characteristics desired and are selected and used in proper amount depending upon the particular type of effervescent composition required (see column 8. lines 21-36).

The '662 patent discloses an effervescent composition in the form of tablets or powder comprising a therapeutic agent, a granulating agent, a microparticulate effervescent component and an effervescent system which dissolve rapidly in water to yield an effervescent solution (see abstract). The '662 patent further teaches that the dissolution of the tablet occurs at 22°C temperature of water (see column 10, lines 63-64).

It is noted that recitation/limitation of instant claim 1 (tablet dissolves in water having a temperature of at least 38°C to form a clear solution) is an inherent feature and as long as all critical elements (structure and composition) as required by instant claims are taught by the cited reference and thus the claims are anticipated.

Regarding the claims 27-29, Rockliffe et al., (US 4,471,871) discloses a method of packaging of tablets in a sealed pouch or packet adapted to torn open when required for use (see abstract). The '871 patent further discloses a safe device of packaging kit for tablet, in such a manner that the tablets are contained with in an airtight sealed container which is impervious to the ingress of moisture (see column 6, lines 1-3). This disclosure renders the claims anticipated.

Regarding claims 35 and 36, it is the position of the examiner that the temperature of the water is not critical or is obvious, when '972 is taken into consideration in view of '468. The prior art provides a method, where an effervescent tablet when dissolved in water produces a solution, which makes it uniquely desirable for use as a mouthwash (Howard P. Andersen, U.S. 3,629,468 see column 1 lines 24-33). Indeed the resulting effervescent mouthwash solution will have the dual role of producing an astringent mouthwash effect and desensitizing action, and which form will lend for long lasting plaque control, decay control, anti-microbial action, breath sweetening whitening and thereof. Therefore, when these references are taken together, water temperature is obvious because of the prior art teaching of dissolution of effervescent tablet to provide a clear solution, which makes it uniquely desirable for use as mouthwash.

Although there is no example contemplated in the patent using a mixture of all the said active agents, it is apparent to one of ordinary skill in the art to make such modification to include these beneficial active agents to maximize effervescent

composition effectiveness because making such modification can enhance industrial applicability.

Each critical element required by the instant claims is taught by cited reference and minor variations such as amounts of active ingredients and carriers, route of application, mixing and adjusting process in order to determine most effective outcome (results) is considered to be well within the skilled level of the artisan.

One would have been motivated to do so, with reasonable expectation of success because it is always desirable to have extended effervescent composition modalities to improve customer's compliance by enhancing customer satisfaction and increasing the selection option. The techniques and skills required for making such substitution is conventional knowledge or well within the skills of ordinary artisan and thus obvious, absent evidence to the contrary. Further given the general teaching of dissolution of effervescent tablet to provide a clear solution, which makes it uniquely desirable for use as mouthwash as disclosed by Howard P. Andersen, one of ordinary skill in the art would have been motivated to employ improved tablet composition comprising effervescent agent as disclosed by Schobel because the use of improved effervescent mouthwash tablets is common in the art of mouthwash solutions to provide a desired effervescent tablet with mouthwash applications as shown by Andersen.

Thus, the claimed subject matter is well within the scope of the patented invention, which renders the claims not patentably distinct over the prior art of the record.

(10) Response to Argument

In response to appellant's argument that Gioffre et al. do not teach an effervescent composition or tablet that includes menthol (from 0.5% to about 10% by weight), eucalyptus oil (from 0.5% to about 10% by weight), anhydrous base medium and a gas containing inorganic oxide material and Gioffre disclose dentifrice compositions and list a series of more than twenty flavoring agents and classes of flavoring agents, it is noted that Gioffre's discloses dentifrice composition comprising menthol and eucalyptus oil as flavoring agents. Further more, regarding to amounts of menthol and eucalyptus oil, Gioffre in column 4, lines 54-56, specially contemplates using flavoring and sweetening agents in an amount of from 0.1 to 10%. In Gioffre's case, the most commonly employed flavoring and/or sweetening agents include menthol and eucalyptus oil (column 4, lines 32-34). Thus, it is clear that Gioffre anticipates using from about 0.1 to 10% of menthol and/or eucalyptus oil. Therefore, although Gioffre, does not specifically state that the use of menthol and eucalyptus oil, Gioffre's composition contains at least one additional component selected from the group consisting of liquid vehicles, flavoring agents (see claim 21).

And since menthol and eucalyptus oil are common flavoring agents known in the art the person of ordinary skill in the art would have good reason to use more than one flavoring agents to optimize the composition in order to achieve the desired flavor.

In response to appellant's argument that Gioffre disclose dentifrice compositions and list a series of more than twenty flavoring agents, but twenty interchangeable well know flavoring agents do not constitute a "laundry list," it is noted that a clear list of

interchange and equivalent flavorings. Additionally the amount of flavoring agents is clearly a result dependent parameter that one skilled in the art would optimize to achieve the desired flavor, weight % of such flavoring agents is disclosed at the end of paragraph (see col. 4, lines 54-56). The disclosed range would clearly encompass the broad range of menthol and eucalyptus oil in the claims.

In response to appellant's argument that Gioffre do not teach a tablet that dissolves in water having a temperature of at least 38°C to form a clear solution, it is noted that dissolution of tablet in water having 38°C is a property of the tablet. And Gioffre tablet would have the ability to dissolve in water.

In response to appellant argument that Gioffre does not direct the skilled artisan to select menthol and eucalyptus oil for inclusion in chewable tablet, it is noted that Gioffre specifically teach effervescent tablets where the most commonly used flavoring agents are menthol and eucalyptus oil (column 4, lines 32-34).

In response to appellant's argument that Gioffre fail to teach or suggest an effervescent agent that includes an acid and a base, it is noted that Gioffre's composition discloses that gas-generating agents such as acid/base reaction couple may be employed when an additional in situ source of a gas is desired, e.g., see U.S. Pat. 3,629,468 (see col. 8, lines 27-32) leading the skilled artisan to do the same.

In response to appellant's argument that Schobel does not cure the deficiencies of Gioffre, it is noted that Schobel was relied upon for showing an effervescent system which dissolve rapidly in water to yield an effervescent solution (clear solution).It is prima facie obvious to combine two compositions each of which is taught by the prior art

to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. See In re Kerkhoven, 626 F.2d 846,850,205 USPQ 1069, 1072 (CCPA 1980).

In response to appellant's argument that Schobel does not direct the skilled artisan to select both eucalyptus oil and menthol for inclusion in a tablet, it is noted that Schobel was relied upon for showing a effervescent composition in the form of tablets comprising effervescent component and as such does not have to direct the skilled artisan to select both eucalyptus and menthol. "The selection of eucalyptus and menthol derives from the teaching Gioffre."

In response to appellant's argument that Schobel refers to ingesting therapeutic agents as opposed to the effervescent composition of Gioffre, it is noted that Schobel in column 5, lines 38-43 discloses effervescent composition. Furthermore, the effect of ingesting and administering solubilized drug as stated by appellant on page 14 of the brief and the chewing of effervescent tablet as taught by Gioffre is the same, which is, making available therapeutic agents present in the dosage forms.

In response to appellant's argument that composition of Gioffre would inherently dissolve in water, it is noted that the dissolution of tablet in water is a property of the tablet and Schobel further teaches that the dissolution of the tablet occurs at 22°C temperature of water. It is further noted that recitation/limitation of tablet dissolves in water having a temperature of at least 38°C to form a clear solution is inherent feature

and as long as all critical elements as required by instant claims are taught by the cited reference and thus the claims are anticipated.

In response to appellant's argument that Gioffre did not teach a tablet and as such there is no inherent dissolution of the tablet, it is noted that Gioffre specially teaches a chewable tablet (column 7, lines 15-20).

In response to appellant's argument that Rockliffe do not cure the deficiencies of Gioffre, it is noted that Rockliffe was relied upon for showing a safe device of packaging kit for tablet, in such a manner that the tablets are contained with in an airtight sealed container which is impervious to the ingress of moisture (column 6, lines 1-3).

In response to appellant's argument that Schobel does not cure the deficiencies of Gioffre's tablet that exhibits a hardness of at least 15 kilopounds, it is noted that any tablet will have certain amount of hardness. So, Schobel's reference was relied upon to show the effervescent tablet having hardness of 7-9 strong cobb. Appellant have not shown that hardness of 10-15 kilopounds provides unexpected results to the tablet.

In response to appellant's argument that the secondary references of Rockliffe and Anderson does not teach or suggest a composition form a mouthwash or dissolving a tablet in boiling water to form a clear solution and then inhaling vapors, it is noted that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, Suggestions, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed.

Cir. 1992). In this case, the prior art provides a method, where an effervescent tablet when dissolved in water produces a solution, which makes it uniquely desirable for use as a mouthwash and the resulting effervescent mouthwash solution will have the dual role of producing an astringent mouthwash effect and desensitizing action, and which form will lend for long lasting plaque control, decay control, anti-microbial action, breath sweetening whitening and thereof. Therefore, when these references are taken together, water temperature is obvious because of the prior art teaching of dissolution of effervescent tablet to provide a clear solution, which makes it uniquely desirable for use as mouthwash.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

SJR

Conferees:

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